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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/752,826

01/06/2004

Claudia Joost

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26252 7590 04/20/2006

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EXAMINER

SAN MARTIN, EDGARDO

ART UNIT

PAPER NUMBER

2837

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H/A

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/752,826	JOOST ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Edgardo San Martin	2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/6/04;12/22/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The reference of the prior art cited as US 5,897,327 to Sato et al. was misnumbered and was not considered, however, the Examiner has included the US 5,857,327 to Sato et al., which he considers id the patent the applicant intended to cite, in the Form PTO-892 included herewith.

### ***Specification***

2. The disclosure is objected to because of the following informalities:
- In the abstract, delete the reference to Fig.1 at the end of the abstract;
  - In the specification, the headings of the different sections of the specification are missing;
  - Delete all the occurrences of direct reference to the claims.

Appropriate correction is required.

### ***Claim Objections***

3. Claims 1 – 20 are objected to because of the following informalities:
- In claim 1, line 1 delete “A silencer (100), in particular an exhaust silencer,”, and insert - - An exhaust silencer (100) - -;
  - Claim 3 should depend upon claim 2, in order to avoid 35 USC 112 issues regarding the recitation of “the second housing” in line 2;
  - Claim 4 should depend upon claim 2, in order to avoid 35 USC 112 issues regarding the recitation of “the second housing” in line 2;

- In all the claims, the use of the phrase "and/or" render the claims indefinite because it is not clear if the limitations are to be considered in combination or in the alternative;
- In all the claims, the use of "characterised in that" should be change to  
- - wherein - - to better comply with the US patent claims format;
- Claims 5 – 20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n).  
Accordingly, the claims have not been further treated on the merits.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 – 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Karlsson (WO 99/17007).

With respect to claim 1, Karlsson teaches a exhaust silencer for an internal combustion engine (Fig.8), comprising a first housing with an inlet aperture and an outlet aperture (Fig.8), wherein an exhaust stream (Fig.8, Item 4) flowing into the inlet aperture and escaping from the outlet aperture is fed via a catalytic converter element (Fig.8, Item 16), wherein a calming chamber is provided between an outlet area (Fig.8,

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Item 17) of the catalytic converter element and the outlet aperture of the first housing (Fig.8).

With respect to claim 2, Karlsson teaches wherein the catalytic converter element (Fig.8, Item 16) comprises a second housing (Fig.8, Item 10), which is arranged within the first housing (Fig.8).

With respect to claim 3, Karlsson teaches wherein essentially the calming chamber is formed by a second inside of the second housing, by the outlet area of the catalytic converter element, and by a recess in the first housing (Fig.8).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Karlsson (WO 99/17007).

Karlsson teach the limitations discussed in a previous rejection, furthermore, Karlsson teaches wherein the second housing (Fig.8, Item 10) comprises at least one retention plate (Fig.8, Item 18) with a margin, whereby a catalytic converter chamber (Fig.8, Item 16) is formed between the retention plate (Fig.8, Item 18) and the second housing (Fig.8, Item 10), but fail to disclose whereby a catalytic converter chamber is formed between an inlet area and the retention plate and the second housing.

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The Examiner considers that it would have been an obvious matter of design choice to provide the catalytic converter chamber being formed between an inlet area and the retention plate and the second housing, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

### ***Conclusion***

6. The attached hereto PTO Form 892 lists prior art made of record that the Examiner considered it pertinent to applicant's disclosure.

### ***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edgardo San Martin whose telephone number is (571) 272-2074. The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (571) 272-2800 ext.33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "E. San Martín".

Edgardo San Martín  
Primary Examiner  
Art Unit 2837  
Class 181  
April 16, 2006